

EXAMINER INTERVIEW SUMMARY RECORD

As Paper No. 11 in this prosecution Examiner Strzelecka issued an Interview Summary. The following description is Applicants' account of the substance of the interviews on July 14, 17, and 20 with Examiner Strzelecka and Applicants' representative Melissa Sistrunk.

Although Examiner Strzelecka at first indicated the pending claims were allowable and suggested several Examiner amendments for clarification of the claims, she later recanted her decision and indicated it was her opinion that the claims were not novel in light of the Matsuura reference (see below). The substance of this issue was not discussed by Dr. Sistrunk.

REMARKS/ARGUMENTS

Claims 1-28 are pending in the application. Claims 1-7, 9, 10, and 14-17 are rejected. Claims 8 and 11-13 are objected to.

Issues under 35 U.S.C. §112, second paragraph

Claims 4, 5, 7, and 14-17 are rejected for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicants respectfully disagree but amend claims 4, 5, 7, 14, 16, and 17 herein without prejudice and without acquiescence to further the prosecution of this case.

Issues under 35 U.S.C. §102(a)

Claim 1 is rejected to under 35 U.S.C. §102(a) as allegedly being anticipated by Matsuura *et al.* (*Ann. Neurol.*, vol. 46, pp. 480-1, September 1999) ("Matsuura"). Applicants respectfully disagree.

The Examiner alleges that Matsuura "teach detection of DNA expansion due to CAG repeats at a gene locus of spinocerebellar ataxia type 10 (SCA10) gene locus." Applicants assert that this reference does not teach this. Matsuura teaches that localization of SCA10 to chromosome 22q13, through linkage and haplotype analysis in a pedigree, narrowed the candidate interval to D22S1153 having a recombination. Further characterization narrowed

the region to 2.7 cM flanked proximally by D22S1140 and distally by D22S1153. They tested polyglutamine expansion in the pathogenesis by performing repeat expansion detection assay and western blotting. *They were unable to detect a long expansion of a CAG repeat using these methods.* Although Matsuura speculates that small expansions of CAG repeats may be involved, such as with SCA6, this certainly does not teach detection of spinocerebellar ataxia type 10 by identifying these repeats.

Given that all elements of the claim are not taught in Matsuura, this rejection is improper. A claim is anticipated only if each and every element as set forth in the claims is found in the reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Although Applicants assert that Matsuura does not teach their invention, Applicants also assert that they are authors of the Matsuura reference cited against the present invention. Pursuant to MPEP §706.02(b), Applicants file herewith a 37 C.F.R. § 1.132 declaration of Dr. Tetsuo Ashizawa that states that the Matsuura reference describes Applicants' own work, and thus the Matsuura reference is not by "another". Thus, in light of the Declaration by Dr. Ashizawa, Applicants have provided sufficient evidence to remove Matsuura as a reference and respectfully request that the rejection be withdrawn. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA).

Issues under 35 U.S.C. §103(a)

Claims 2-4, 6, and 7 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Matsuura *et al.* (*Ann. Neurol.*, vol. 46, pp. 480-1, September 1999) ("Matsuura") and Koob *et al.* (*Nat. Genet.*, vol. 21, pp. 379-384, April 1999) ("Koob"). Claim 9 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Matsuura *et al.* (*Ann. Neurol.*, vol. 46, pp. 480-1, September 1999) ("Matsuura") and Del-Favero *et al.* (*Hum. Genet.*, vol. 105, pp. 217-225, September 1999) ("Del-Favero"). Claim 10 is rejected as allegedly being unpatentable over Matsuura *et al.* (*Ann. Neurol.*, vol. 46, pp. 480-1, September 1999) ("Matsuura") and Haaf *et al.* (*Nat. Genet.*, vol.12, pp. 183-185, 1996). Applicants respectfully disagree.

Although Matsuura guesses that SCA10 is caused by small expansions of repeats like SCA6, this does not render Applicants' pending claims obvious. Applicants also suggest the Examiner is improperly citing an obviousness rejection wherein the rejection is more accurately an "obvious to try" rejection. The "obvious to try" standard has been held to constitute an improper ground for a 35 U.S.C. § 103 rejection. *In re O'Farrell*, 858, F.2d 894, 903 (Fed. Cir. 1988). An "obvious-to-try" situation exists when a general disclosure may pique an inventor's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result or indicate that the claimed result would be obtained if certain directions were pursued. *In re Eli Lilly & Co.*, 902 F.2d 943 (Fed. Cir. 1990).

Furthermore, although Applicants assert that Matsuura does not teach their invention nor is their invention obvious in light of Matsuura alone or in combination with other references, Applicants file a 37 C.F.R. § 1.132 declaration of Dr. Tetsuo Ashizawa asserting that the Matsuura reference, of which he is a co-author, is Applicants' own work. In light of the above arguments and the submitted declaration, Applicants respectfully assert that the rejections related to Matsuura in combination with other references should be removed.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P02039US1 from which the


Application No.: 09/942,336

Docket No.: HO-P02039US1

undersigned is authorized to draw.

Dated:

Respectfully submitted,

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